



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,372	11/23/2001	Katsuaki Yamanoi	041465-5128	3256

9629 7590 05/13/2004

MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

EXAMINER

PSITOS, ARISTOTELIS M

ART UNIT	PAPER NUMBER
----------	--------------

2653

DATE MAILED: 05/13/2004

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/990,372

Applicant(s)

YAMANOI ET AL.

Examiner

Aristotelis M Psitos

Art Unit

2653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 2653

DETAILED ACTION

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

The IDS of 8/5/03 has been reviewed and made of record.

Drawings

The drawings were received on 8/5/03. These drawings are acceptable by the examiner.

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Objections

Claim 23 is not decipherable. Dependent claim 24 falls accordingly.

As far as the claims recite positive limitations and as interpreted, the following rejections are made.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In particular, independent claim 1 is written as a single means claim - see In re Hyatt, 708 F.2d 712, 218 USPQ 195. Dependent claims add no further

Art Unit: 2653

apparatus limitations and fall therewith. In fact these claims are written in purely resultant/desired result format.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Art Unit: 2653

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1,21-22 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Morohashi document.

With respect to the independent claim the system – see abstract, permits a user to influence the ability of associating a plurality of files in "groups". This is done by having the recited "group management data". This meets the independent claim.

With respect to dependent claim 21 and 22, these claims call for a register, which registers which tracks belong to the same group. Applicants' attention is drawn to figures 6a-c and the associated disclosure with respect to managing pieces of music data – inherently there is a register in the overall system – CPU (microprocessor/controller) that permits the association of that/those information tracks belong to what group. This is commonly preformed by the pointer ability in this environment.

The examiner concludes that under 102 considerations, such register(s)/apparatus is inherently present in the Morohashi document, and inherently track association – which tracks belong to which group is present.

If applicants' could convince the examiner that such is not present then the examiner would rely upon Heo et al for teaching start and ending (pointing) address ability with respect to his audio stream attribute table information –

It would have been obvious to modify the base system of Morohashi with the above teaching from Heo et al, motivation is to permit multi-tracks to be associated with particular groups.

Art Unit: 2653

10. Claims 1-22 rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/34601 to Otomo et al further considered with Yokota et al.

These references are relied upon for the reasons stated in the submitted search report.

As far as the examiner can ascertain, all the above limitations are indeed present.

The base reference to Otomo et al as indicated on page 35 to page 36 has a single means that permits the recording/giving of a group instruction/management data when "any kind of change regarding track recording is detected".

With respect to the particular types further elaborated upon by the dependent claims, these are taught by the secondary reference to Yokota et al at the indicated passages.

It would have been obvious to modify the base system of Otomo et al with the above additional teachings from Yokota et al, motivation is to permit the system to give group instruction(s) during/for particular events as indicated.

Again, the register(s) limitations of claims 21 & 22 are considered inherently present .

11. Claims 1-3,8-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Heo et al.

Heo et al is a DVD audio disc recording system, which permits the user to associate information into groups as the user designs/selects. – see the abstract. See the discussion with respect to audio packets having the appropriate quantization, sampling, title management table, etc..

Since the Heo et al system permits various audio modes/types/formats the examiner interprets this ability as meeting the "any kind of change" language in claim 1.

With respect to claim 2, this is interpreted as the finish/done end of group/track indication.

With respect to claim 3, numbering system continuously increases.

With respect to claim 8, the examiner interprets this as the different format ability in Heo et al.

With respect to claim 9, this is inherent otherwise any change in-group information would be lost.

With respect to claim 10, again numbering continuously increases.

With respect to claim 11, operating state is interpreted as a different sampling/quantization level.

Art Unit: 2653

With respect to claim 12, subsequent group indication/data is not the same as that previously recorded.

With respect to claim 13, again, track numbering continuously increases.

With respect to claim 14, recording mode – see discussion with respect to MPEG2, or alternatively, stereo and mono modes.

With respect to claim 15, yes otherwise distinction between groups would not be detectable.

With respect to claim 16, continuously increasing of track numbering.

With respect to claim 17, input source designation.

With respect to claim 18, see discussion with respect to claim 15.

With respect to claim 19, see discussion with respect to claim 16.

With respect to claim 20, recording is sequential.

With respect to claims 21-22, registers are considered inherently present in the Heo et al system, which are used to discriminate the associated table information.

12. Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 1 above, and further in view of Yokota et al.

Heo et al do not specify pause ability.

Yokota et al teaches in this environment the ability to pause the system and provide management information indicative thereof.

It would have been obvious to modify the base system of Heo et al with the above pause ability indication so as to permit a user to discriminate between “paused” conditions and hence increase the flexibility of Heo et al by letting the system provide appropriate indication thereof. The use of “pause” ability especially in DVD systems is considered motivation, i.e., permitting systems to keep track and indicate pauses.

13. Claims 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 1 as stated in either paragraphs 10 & 11 above, and further in view of well known word processing nomenclature and the Dewey-Decimal system.

Art Unit: 2653

With respect to claim 23, the examiner interprets such to mean an indication of various versions of a recording. This ability to indicate versions is well known in the word processing arts, i.e., version 1, version 2, etc. Hence, the examiner concludes that one of ordinary skill in the art to use such well-known nomenclature to permit various version identification, motivation is to permit historical recording of tracks to be noted.

With respect to claim 24, the ability of having a numbering scheme using "sub-number" is considered well established – as taught by the Dewey-decimal system.

It would have been obvious to modify the base system as indicated above in either paragraphs 10 and 11 with this ability, motivation is to permit a finer division of tracks.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Okada et al also is an audio table recording system, which can be relied upon in place of Heo et al for the same teachings.

Maeda et al is an audio signal recording system providing for various encoding abilities.

JP 10-336579 is another prior art "group" recognition system.

Hard copies of the application files are now separated from this examining corps, hence the examiner can answer no questions that requires a review of the file without sufficient lead-time.

Any inquiries concerning missing papers/references, etc. must be directed to Group 2600 Customer Services at (703) 306-0377.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M Psitos whose telephone number is (703) 308-1598. The examiner can normally be reached on M-Thursday 8 - 4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William R. Korzuch can be reached on (703) 305-6137. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2653

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Aristotelis M Psitos
Primary Examiner
Art Unit 2653

A handwritten signature in black ink, appearing to be 'A. Psitos', written over the printed name and title.

AMP